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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,454	05/24/2001	Satoru Kosuge	DP-767 US	9838

466 7590 09/20/2004  
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EXAMINER

PHILLIPS, HASSAN A

ART UNIT PAPER NUMBER

2151

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/863,454

**Applicant(s)**

KOSUGE, SATORU

**Examiner**

Hassan Phillips

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-29 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/18/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The Information Discloser Statements (IDS) filed June 18, 2004, February 24, 2004, and February 25, 2003, have been received and considered by the Examiner.

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference characters showing steps (4) and (5) in Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

1. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim, which depends from a dependent claim (i.e. claims 21, 23, 26-28), should not be separated by any claim, which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the claim, the term "reply repetitive" is unclear to the Examiner. The term was also not described in the specification in such a way as to enable one skilled in the art to use the invention. In order to advance prosecution of the application for patent, the Examiner has interpreted the term as best understood.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1, 3, 6, 7, 11, 14, 15, 17, 19, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fernandez, WO 99/65256 (supplied by Applicant).

3. In considering claims 1, 3, 11, and 17, Fernandez teaches an electronic mail processing system, method, and device comprising:

Receiving means for receiving electronic mail sent to a receiver via internet; analysis means for receiving the electronic mail sent from a sending means via the internet and for carrying out a keyword analysis of the received electronic mail on the basis of keywords previously registered by the receiver to obtain a short text of the electronic mail; storing means for storing the short text of the electronic mail obtained after the keyword analysis; and sending means for sending the short text of the electronic mail stored in the storing means to the receiver via the internet in response to access of the receiver, (page 5, lines 1-15).

4. In considering claims 6, 14, and 19, Fernandez teaches an electronic mail processing system, method, and device comprising:

Receiving means for receiving electronic mail sent to a receiver via internet; voice conversion means for receiving the electronic mail sent from a sending means via the internet and for converting content of the received electronic mail into voice signals; reading out means for reading out the voice signals output from the voice conversion means to produce voiced electronic mail; and sending means for sending the voiced electronic mail produced by the reading out means to the receiver via a public telephone network in response to access of the receiver, (page 5, lines 1-15).

5. In considering claim 7, the teachings of Fernandez further show a document output means for outputting a selected reply document in response to a signal sent from the public telephone network, and a reply sending means for preparing electronic mail from the reply document output from the document output means and for sending the prepared electronic mail to the electronic mail sender via the Internet. See page 6, lines 10-16.

6. In considering claim 15, the teachings of Fernandez show the electronic mail to be converted into the voice signals being the short text of the received electronic mail obtained by carrying out a keyword analysis of the electronic mail on the basis of keywords previously registered by the receiver. See page 5, lines 1-15.

7. Claim 10, is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Nelson, U.S. Patent 6,061,718 (supplied by Applicant).

8. In considering claim 10, Nelson teaches an electronic mail processing system comprising:

First sending means for sending voiced electronic mail to a receiver via a public telephone network; conversion means for receiving the voiced electronic mail sent from the first sending means via the public telephone network and for converting content of the voiced electronic mail into a text as content of a communication matter; storing means for storing the voiced electronic mail of a destination text converted by the conversion means; and second sending means for sending the received electronic mail stored in the storing means to the receiver via the internet in response to access of the receiver of the voiced electronic mail, (col. 4, lines 59-67, col. 5, lines 1-3).

9. Claims 5, 12, 18, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Scannell et al. (hereinafter Scannell), U.S. Patent 5,377,354 (supplied by Applicant).

10. In considering claims 5, 12, and 18, Scannell teaches an electronic mail processing system, method, and device comprising:

Receiving means for receiving electronic mail sent to a receiver via internet; rearrange means for receiving the electronic mail sent from a sending means via the

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internet and for rearranging the received electronic mail in a priority order previously registered by the receiver, storing means for storing the received electronic mail rearranged by the rearrange means; and, sending means for consecutively sending the received electronic mail stored in the storing means in the stored order to the receiver via the internet in response to access of the receiver, (col. 2, lines 49-68, col. 3, lines 1-11).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 4, 8, 9, 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez in view of Scannell.

3. In considering claims 2, 4, 8, 9, and 16, although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose:

a) Rearranging the received email.

Nevertheless, in a similar field of endeavor, Scannell teaches a method and system comprising:

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- a) A rearrange means for receiving electronic mail sent from a sending means via the Internet and for rearranging the received electronic mail in a priority order previously registered by a receiver of the electronic mail, (col. 2, lines 34-48).

Thus given the teachings of Scannell, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to show the receiver registering electronic mail in a priority order so that the received electronic mail can be rearranged for the receiver. Doing so would have provided the receiver with an improved automatic message sorting system driven by the rules created and modified by the receiver, (col. 2, lines 28-31).

4. Claim 13, is rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Fernandez.

5. In considering claim 13, the method taught by Scannell further shows:

- a) Carrying out a keyword analysis of the rearranged electronic mail stored in the receive mail box on the basis of keywords previously registered by the receiver to obtain the electronic mail; and storing the electronic mail after the keyword analysis in the receive mail box, (col. 7, lines 30-68, col. 8, lines 1-19).

Although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose:

- b) Obtaining a short text of the electronic mail.

Nevertheless, Fernandez teaches a method comprising:

- b) Obtaining a short text of the electronic mail, (page 5, lines 1-15).

Thus given the teachings of Fernandez, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Scannell to show the receiver obtaining a short text of the electronic mail. This would have provided an efficient means for allowing the receiver to see a summarized version of the electronic mail that would fit on the display of the receivers mobile device, (page 5, lines 5-7).

6. Claims 20, 22, 25, 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez in view of Chong et al. (hereinafter Chong), U.S. Patent 5,497,319 (supplied by Applicant).

7. In considering claims 20, 22, 25, and 26, although the disclosed system of Fernandez shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising:

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- a) A conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Fernandez to have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

8. Claims 21, 23, 27, 28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez and Scannell, in view of Chong.

9. In considering claims 21, 23, 27, and 28, although the disclosed system of Fernandez and Scannell shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising:

- a) A conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Fernandez and Scannell to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

10. Claim 24, is rejected under 35 U.S.C. 103(a) as being unpatentable over Scannell in view of Chong.

11. In considering claim 24, although the disclosed system of Scannell shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising:

- a) A conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link; (col. 3, lines 33-54).

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Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Scannell to have a have a conversion processor between a personal computer and a mobile device. This would have allowed to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

12. Claim 29, is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Chong.

13. In considering claim 29, although the disclosed system of Nelson shows substantial features of the claimed invention, it fails to expressly disclose:

- a) Sharing a conversion processor or language dictionary between a personal computer and a mobile device.

Nevertheless, conversion processors, or language dictionaries were well known in the art at the time of the claimed invention. This is exemplified through the teachings of Chong, whereby Chong shows a telecommunication system comprising:

- a) A conversion processor/language dictionary that receives input from a first telecommunications link, and sends translated output to the address of the recipient via a second telecommunications link, (col. 3, lines 33-54).

Thus given the teachings of Chong, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Nelson to have a have a conversion processor between a personal computer and a mobile device. This would have allowed

to owner of the mobile device to communicate with a plurality of devices that utilize different languages, (col. 3, lines 16-33).

### ***Conclusion***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tobias et al., U.S. Patent 6,732,151 discloses a method for forwarding voice-to-text electronic messages.

Aronson et al., U.S. Patent 6,654,787 discloses a method and apparatus for registering specific electronic messages to be delivered to a client.

Groner, U.S. Patent 6,507,643 discloses system and method for converting voice mail messages to electronic mail messages.

Haneda et al., U.S. Patent 6,189,027 discloses system for assigning priorities to electronic mail.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (703) 308-6687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP/  
9/13/04

  
**FRANTZ B. JEAN**  
**PRIMARY EXAMINER**